

REMARKS

The Examiner has made an election of species requirement requiring election between the claims directed to the following species of the instant application and of which the Examiner considers to be distinct:

- | | |
|------------------------------------|----------------------------------|
| a. figs. 6-8 (first embodiment) | e. fig. 23 (fifth embodiment) |
| b. figs. 17-18 (second embodiment) | f. fig. 24-26 (sixth embodiment) |
| c. figs. 19-20 (third embodiment) | g. fig. 27 (seventh embodiment) |
| d. fig. 21 (fourth embodiment) | |

As stated above, Applicants elect the species of figs. 6-8 along with the photodetector presented therewith, for which claims 21-23 and 29-37 are readable thereon. Additionally, Applicants respectfully submit that claim 21 is generic. Applicants respectfully traverse the election of species requirement and respectfully request the election of species requirement be withdrawn. Furthermore, the Examiner is reminded that should no prior art be found rendering the generic claim nonpatentable the search of the application should be extended to the non-elected species as instructed in MPEP § 809.02(c).

Applicants respectfully submit that the election requirement is improper. The Examiner has stated at page 2 of the Restriction Requirement that the application “contains claims directed to the following patentably distinct species of the claimed invention: The optical storage device of: [a. - g.]. . . . Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are considered generic.” MPEP § 808 provides two aspects that must be provided by an Examiner when requiring a restriction: (A) the reasons why the inventions as claimed are distinct and (B) the reasons for insisting upon the restriction as set forth in MPEP sections 808.01 and 808.02. The Examiner has provided no rationale for the restriction requirement and therefore the restriction is improper and should be withdrawn for at least this reason. In addition, Applicants respectfully submit that the species (a. – g.) are not patentably distinct as alleged and therefore the restriction requirement is improper. Evidence to that effect is provided in the application as originally filed, for example, at pages 37 – 40 and figures 17-21 second through fourth embodiments of the focus error detecting optical element with obvious variants with respect to one another.

As a result, Applicants respectfully request that a search for the subject matter and

examination of the entire application with respect to claims 21-40 be undertaken. Applicants respectfully request the timely allowance of all of the pending claims because there should be no serious or additional burden on the Examiner to consider all of the pending claims.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Dated: October 20, 2004

By:  

David J. Baltazar (Reg. No. 53,964)

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202.739.3000; Fax: 202.739.3001